

REMARKS

The present invention addresses a specific environment, for example in a gambling casino that wishes to provide a very compact money dispensing device including banknotes, tokens and coins. Besides having a limited compact configuration, the token dispensing and banknote changing device of the present invention includes a modular banknote receiving unit, a banknote dispensing unit and a token dispensing unit with a control unit stacked in a vertical column. This arrangement is to accommodate the user, for example in a sitting position adjacent a gaming machine such as a slot machine. With this arrangement, the banknote receiving slot and the banknote dispensing slot are located close to each other at a location almost level with a user's eyes when seated.

As can be seen in Figure 2, a token dispensing and banknote changing device 81 of the present invention, can be conveniently mounted between, for example, a pair of gambling machines 101. As can be appreciated, it is highly desirable in a casino environment to enable a customer to remain seated and playing at a gambling machine to increase the amount of play time. The present invention facilitates one of the major issues in a customer leaving a machine to seek additional tokens to continue play.

To facilitate such a compact design, a U-shaped passageway or transporting path permits an extended transportation of a banknote while minimizing the actual depth required for a banknote of dispensing unit of a modular configuration. A U-shaped passageway or transporting path has been designed to not only move the banknotes at optimum speeds without damaging the banknote, but further provides the capability to validate the banknotes.

A safe storage of an approximately trapezoidal shape stores banknotes and has also been designed for ease of removal and position the banknotes at an inclined orientation relative to the horizontal in order to maintain the compact configuration.

Thus, a series of coordinated engineering design features were considered to address a specific environment that is not recognized nor suggested by any of the combination of references of record.

With the increase in legalization of gaming casinos, there has been a significant increase in addressing the needs of such customers by relatively skilled engineers. This is a relatively crowded field and the patentability of our claims should be considered in view of this environment.

“Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light.”

Continental Can Co. USA Inc. v. Monsanto Co., 20 U.S.P.Q. 2d. 1746, 1752 (Fed. Cir. 1991).

The present invention has been rejected over an aggregation of separate features from four to seven different patent references.

As the Examiner is aware, the hard question is whether the combination is based upon hindsight from the present teaching rather than what would be obvious apart from the present teaching to a person of ordinary skill in this field.

As set forth in *In re Kahn*, 441 F.3d 977, 987-988 (Fed. Cir. 2006):

The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the *Graham* analysis. [*Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).]

To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law. . . .

* * *

A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as “the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. This requirement is as much rooted in the Administrative Procedure Act [for our review of Board determinations], which ensures due process and non-arbitrary decision making, as it is in §103.

As can be appreciated, the more that the cited references must be modified to meet the outstanding claims, the more likely that an unintended issue of hindsight may drive the rejection. This is particularly true for an Examiner who is attempting to provide a diligent effort to ensure that only patentable subject matter occurs. The difficult issue is to step back from the zeal of the examination process and to appreciate that the Patent Examiner has to wear both hats of advocating a position relative to the prior art, while at the same time objectively rendering in a judge-like manner, a decision on the patentability of the present claims.

The Office Action contended that Claims 1, 2, 3, 19 and 20 were rendered obvious over a combination of the *Sagady* (U.S. Patent No. 6,155,398) in view of *Matuura et al.* (U.S. Patent No. 4,795,889) when taken further in view of *Kawasaki* (U.S. Patent No. 4,895,358) and *Arimoto et al.* (U.S. Patent No. 4,365,700).

The basic *Sagady* reference was directed to a coin jam detection system for apparently the dispensing of a candy bar to enable a transaction with a customer in the field of vending machines. That is, a vending machine which could be tampered with by a user trying to jam a coin was the issue addressed by the *Sagady* reference. See Column 2, Lines 1-5.

The Office Action cited the *Matuura et al.* reference for its teaching of an automatic teller machine with a customer sensor that can interrupt a bill refilling operation to avoid any inconvenience to a customer. Thus, a person of ordinary skill in this field would appreciate that the improvement taught is the concept of a “customer sensor” that can automatically interrupt an internal resupplying bill operation in the automatic teller system. The automatic teller system has the capacity of receiving bills and using the stored bills as a source to replenish the storage bank for dispensing bills.

The Office Action simply aggregates a feature from *Matuura et al.* into the *Sagady* reference without any consideration for a rational underpinning to support the conclusion of obviousness.

As noted in the cited MPEP §2141 (pg. 2100-120):

When applying 35 U.S.C. §103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, U.S.P.Q 187 n.5 (Fed. Cir. 1986). (Emphasis added.)

The *Arimoto et al.* reference was cited for its teaching of bill length sensors 53A-D, with a contention that it would be obvious to incorporate such length sensors into the *Sagady* banknote dispensing validator.

Finally, the *Kawasaki* note feeding device was cited for a trapezoidal configuration to feed notes into an automatic teller machine. Actually, the *Kawasaki* reference would teach a person of skill in the field to provide an improvement of a spring plate to be automatically adjusted to accommodate the wear on a feeding out roller, to thereby keep a constant contact pressure. See Column 1, Lines 58-63.

The Office Action cited the *Arimoto et al.* disclosure for its teaching of a “U-shaped transporter 28.” As can be appreciated, *Arimoto et al.* is actually directed to an automatic banking system where the prior art stacked money cartridges are to be replaced by a single large money cartridge 44D, so that it can replenish individual money cases 44A, 44B, and 44C.

It is respectfully submitted that the Office Action’s reliance on the extremely large “U-shaped transporting system” to accommodate the collection of bills from stacked money case 44D, and then distribute the bills through the elongated transportation system so that they can be dispensed into the individual money cases is not similar to the structure of the present claims, nor the purpose of a very compact device approximating a depth not much greater than an actual bill length.

Claim 4 was rejected over a combination of *Sagady*, *Matuura et al.*, *Kawasaki* and *Haney et al.* (U.S. Patent No. 6,682,068). *Haney et al.* was cited for the teaching of a one-way clutch mechanism in an automatic banking system where bills can be held in a relatively flat position in

horizontal storage areas. See Figure 4. It does not teach an inclining of banknotes to provide a compact dispenser in width and depth dimensions as desired by our present invention.

Claims 5 and 6 were rejected over *Sagady, Matuura et al., Kawasaki, Haney et al., and Winstanley* (U.S. Patent No. 5,400,891). The *Winstanley* reference was directed to a coin testing machine with a plurality of coin storage tubes for paying out change or giving prizes. In essence, different sized coin tubes could be connected to a U-shaped plastic cassette (Figure 1) wherein apparently features of security and a compact configuration were not of the highest important. Rather, a very economical coin cassette was taught.

Claims 7-17 were rejected over a combination of *Sagady, Matuura et al., Kawasaki, Haney et al., Winstanley* and *Cole* ((U.S. Patent No. 6,860,814). Needless to say, none of these references teach the configuration defined in our current claims. The *Cole* reference was simply cited for a door with hinges and a lock, but did not teach the specific configuration defined in our claims. Rather, the Office Action contended that the features of our dependent Claims 12-17 would simply be obvious without citing a specific teaching. Applicants respectfully traverse this position.

“ . . . when the examiner judicially notices or to show wherein such matter, and such is challenged, there is reversible errors when the examiner fails to cite the well known thing on which he relies.”

Ex parte *Noel*, 158 U.S.P.Q. 237 (P.O. Board of Appeals) July 1968.

Claim 18 was rejected over the *Sagady* reference in view of *Saltsov et al.* (U.S. Patent No. 6,371,473) and the *Arimoto et al.* disclosure. *Saltsov et al.* was relied upon for purportedly teaching a combination banknote validator, banknote dispenser and validator dispenser having modular components. Additionally, *Saltsov et al.* was also cited for teaching a U-shaped passageway as element 850 in Figure 29. The *Saltsov et al.* reference was directed to a modular

component banknote validator that utilized a validator at the top of the machine and a vertical pathway is then utilized for a pair of accumulators located underneath. See Column 4, Lines 18-13. The banknotes enter any of the specific accumulators by engagement with thin tape belt strips 124-126 to prevent any slipping. See Column 5, Lines 4-25.

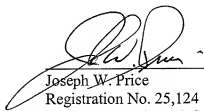
A friction clutch is associated with the reels of the tape spools. As can be readily determined, the one-way clutch of our present invention is not equivalent to a friction clutch and is used in our invention to prevent damage by accommodating different speeds when translating banknotes within our device. Additionally, our device utilizes a particular U-shaped transportation system to accommodate an inclination of the stored bills to conserve space. We specifically define a banknote supply storing section at the top and a rejecting banknote storing section at the bottom, with a banknote supply storing section being arranged in a horizontally inclined trapezoidal configuration above the rejected banknote storing section, and a banknote receiving unit and a token dispensing unit stacked in a vertical column. This arrangement is not taught nor suggested by any combination of the references of record.

In summary, it is believed that our currently amended claims more than adequately define over the accumulated features from an aggregation of references. It is believed that we have more than adequately met the standards of 35 U.S.C. §103 in having an unobvious invention as defined by our currently amended claims.

If the Examiner believes that a telephone interview will help further the prosecution of this case, the undersigned attorney can be contacted in the listed phone number.

Very truly yours,

SNELL & WILMER L.L.P.



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